

REMARKS

This Amendment is responsive to the Advisory Action dated April 21, 2005. In the Advisory Action, the Examiner did not enter Applicant's amendments stating the Amendments raised new issues.

In the Advisory Action, the Examiner maintains her position that the claims are anticipated by the Israel system in which buyers and sellers of a marketplace manually enter all data into a standalone dispute resolution system.¹

Applicant has amended claims 49, 52, 53, 55, 58, 61-63 and 65 for purposes of clarification unrelated to patentability. As explained in further detail below, the Examiner has erroneously relied on subject matter that does not qualify as prior art under 102(e). Nevertheless, Applicant has amended the claims for clarification purposes. In addition, Applicant has added new claims 66-72. Claims 49-72 are pending upon entry of this Amendment.

Claim Rejection Under 35 U.S.C. §§ 102 and 103

In the Advisory Action, the Examiner maintained the rejection of claims 49-54 and 57-63 under 35 U.S.C. 102(e) as being anticipated by Israel et al. (US 6,766,307). Applicant respectfully traverses the rejection. In addition, the Examiner rejected claims 55 and 56 under 35 U.S.C. 103(a) as being unpatentable over Israel et al. as applied to claim 49 above, and further in view of Sloo (US 5,895,450).

Improper reliance on Israel

As discussed in Applicant's last response, the Examiner has erroneously relied on subject matter that does not qualify as prior art under 102(e). 35 U.S.C. 102(e) states:

A person shall be entitled to a patent unless: ...

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ...

¹ See, e.g., Office Action dated 2/17/05, pg. 10, ll. 8-10, where the Examiner rejected claim 1 stating "the data relevant to the dispute [manually] input by the parties could include transaction data.... Even with the parties manually entering the data describing the dispute ..." (emphasis added).

The present application is a continuation of and claims priority to Serial No. 09/504,159, filed February 15, 2000. Israel was filed May 11, 2000, which is nearly three months after Applicant's priority date of February 15, 2000, but claims priority to six U.S. provisional applications filed prior to the priority date of the present application.

MPEP 2136.03 states that the 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application **if the provisional application(s) properly supports the subject matter relied upon** to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

In the Advisory Action, the Examiner made a general statement that the priority documents describe a dispute resolution system. Although this is true, many of the specific features relied upon by the Examiner in rejecting Applicant's claims are not taught or suggested by the priority documents. Consequently, in accordance with MPEP 2136.03, the Israel reference does not receive the benefit of the filing dates of the priority documents when these undisclosed features are relied upon by the Examiner.

Claims 49-63

Applicant's amended independent claim 49 is directed to a system as follows:

A system comprising:

an online dispute resolution system electronically coupled to an electronic marketplace, wherein the electronic marketplace stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services,

wherein, in response to initiation of a dispute, the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data, and

wherein the dispute resolution system utilizes the received portion of the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

Similarly, Applicant's amended independent claim 58 is directed to a method as follows:

A method comprising:

providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace;

electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute; and

utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

As correctly recognized by the Examiner, the Israel dispute resolution system is electronically accessible via the Internet and requires the parties to manually enter all data into the Israel dispute resolution system. Applicant has amended claims 49 and 54, as illustrated above, to require that at least a portion of transaction data stored within an electronic marketplace is received and used by the dispute resolution system without manual entry or intervention in response to initiation of a dispute. At least these features of claims 49 and 58 are not taught or suggested by Israel or any other reference of record, either singularly or in combination. For at least these reasons, the rejection of claims 49-63 should be withdrawn.

New Claims:

Applicant has added claims 66-72 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed inventions.

No new matter has been added by the new claims. Support for the new claims can be found throughout the present specification including, for example, [0046]-[0048].

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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